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Claim 2 Is Patentable

As discussed in the telephone conference, claim 2 recites features that Pejchar teaches away from, such that a person of ordinary skill in the art would have been motivated away from a combination rendering claim 2 obvious. References cannot be combined for purposes of §103 where the reference teaches away from their combination, as elucidated in MPEP §2145(X)(D)(2) and *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983). Therefore, a combination of Pejchar and King does not render claim 2 obvious under §103.

In particular, it was indicated in the Office action that claim 2 differs from Pejchar in reciting wherein the intermediary connecting member includes a portion for flexibly supporting the dangling element. In the Office action, King was said to have supplied the elements needed to combine with Pejchar. (The Office action refers interchangeably to King and Simpson, but cites elements and reference labels making it apparent that King was intended.) However, Pejchar specifically teaches that the links of the drop chain e' serve the specific purpose of enabling different links inserted through the post a to effectuate different lengths for the drop e (column 2, lines 37-39). As another particular example, Pejchar teaches that the separate drop e is enabled to be attached to the post a with or without the intermediate member d.

Pejchar teaches that it is the large variety of different combinations enabled by these features that provide its inventive advantages; but that variety of combinations is substantially diminished by substituting the subject matter of King, wherein the intermediary connecting member (26) includes a portion (28) for flexibly supporting the dangling element (32), as in the Office action. Therefore, to combine the references as suggested by the examiner would clearly contravene the specific teachings of Pejchar, destroying what Pejchar teaches to be the

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desired versatility indicated to be a fundamental advantage of inserting the post a through links of the drop e. The surprisingly different and contradictory structure defined by claim 2 constitutes considerable evidence that Pejchar and King could not form an objectively motivated combination that would render claim 2 obvious.

As yet another example, Pejchar shows drop e hanging from post a such that the chain of drop e is actually positioned between the intermediate member d and the wearer's earlobe (e.g. Fig. 1), and specifically teaches that the chain e' would exert pressure on the earlobe (column 2, lines 41-45). This would likely have pinched or abraded the earlobe and been uncomfortable and inconvenient. The structure and functionality defined by claim 2 therefore provides substantial and surprising advantages over Pejchar by providing for a dangling element that hangs free from an intermediate element, thereby without pinching the earlobe, in combination with wherein the intermediate element removably engages the conical element. Claim 2 therefore defines a combination of elements that is not a mere matter of design choice that would have been obvious to one skilled in the art, but rather that provides a superior function to either Pejchar or King, providing further formidable evidence that claim 2 is inventive and nonobvious. Therefore, due at least to these examples of the non-obviousness of claim 2, the applicant believes allowance of claim 2 is appropriate, and respectfully requests that the Office find likewise.

Claims 11-13 and 15-19 Are Patentable

As discussed in the telephone conference, claims 11-13 and 15-19 are also believed not to have been obvious to one of ordinary skill in the art at the time the invention was made, including for reasons analogous to those laid out above with reference to claim 2. Claim 15 is dependent on claim 2 and is

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believed to be unobvious at least due to that dependency and the unobviousness of claim 2 as outlined above. Claims 11-13 and 16-19 similarly define inventions that Pejchar teaches away from, in the manner outlined above, such that Pejchar and King would not form an objectively motivated combination that would render claims 11-13 and 16-19 obvious. Therefore, due at least to these illustrative examples of the unobviousness of claims 11-13 and 15-19, the applicant believes allowance of these claims is appropriate.

Allowance of claims 2, 11-13 and 15-19, in addition to the indicated allowance of claims 3-10, is therefore respectfully solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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